

Remarks/Arguments:

DETAILED ACTION

Claims 1, 3-10 and 16-22 are currently pending in the instant application. Applicants have cancelled claim 2 in the amendment filed on May 2, 2007.

I. Priority

The instant application is a 371 of PCT/GB04/03364, filed on August 4, 2004 and claims benefit of Foreign Application UNITED KINGDOM 0318464.5, filed on August 7, 2003.

Applicants note the Examiner acknowledges the claim to priority.

II. Information Disclosure Statement

The Examiner states that the information disclosure statements (IDS) submitted on May 31, 2006 and May 2, 2007 are in partial compliance with the provisions of 37 CFR 1.97 because of missing English translations or a concise explanation of the relevance and accordingly, the information disclosure statements have been partially considered by the examiner.

Applicants respectfully ask the Examiner to reconsider the Information Disclosure Statements (SB08's). In all instances where the Examiner has not considered the documents, Applicants were able to locate the English abstracts for these documents in the file in PAIR - they were included in the original submission. The abstracts are easily locatable amongst the other documents because they are indexed as "Foreign Reference" but are 1-2 pages long.

The Examiner will be aware of 37 C.F.R. § 1.98 "Content of information disclosure statement" where under (a) (3) Applicants are asked for a "concise explanation of the relevance ... of each patent, publication, or other information listed that is not in the English language" and only a copy of the translation if "within the possession" or "readily available".

In the MPEP under 609.04 (a) "III. CONCISE EXPLANATION OF RELEVANCE FOR NON-ENGLISH LANGUAGE INFORMATION" it is stated that "Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation".

Applicants consider that they fulfilled the IDS requirements by the provision of English abstracts for the indicated documents at the time of filing the IDS. These abstracts are in the USPTO's file in PAIR, therefore Applicants kindly request that the Examiner reconsiders the SB08s and the documents contained therein.

III. Restriction/Election

A. Election : Applicant's Response

Applicants' election without traverse of Group I in the reply filed on May 2, 2007 is acknowledged by the Examiner. Applicants' request to retain the original definition of variable "r" in claim 1 has been permitted by the Examiner.

Applicants thank the Examiner.

Subject matter not encompassed by elected Group I are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

Applicants note this.

IV. Rejections

Claim Rejections - 35 USC § 112

(1) Claims 1, 3-10 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the term "prodrug" in the above claims are not defined in the specification so as to know the structures of the compounds that are included and/or excluded by the term and therefore, the specification lacks adequate support for Claims 1, 3-10 and 17.

Whilst Applicants do not agree with the Examiner on this point, the term has been removed from the claims in order to Expedite prosecution.

(2) Claims 1, 3-10 and 17 are rejected under 35 U.S.C. 112, first paragraph, because, the Examiner states, the specification, while being enabling for a compound of formula (1) (See pages 6 and 7 of the specification), does not reasonably provide enablement for a prodrug of a compound of formula (1).

As stated above, the term has been removed from the claims in order to Expedite prosecution.

Claim Rejections - 35 USC § 112, 2nd paragraph

Claims 3-10 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. Applicants' claim recites "A compound of the Formula (1), or an in vivo hydrolysable ester thereof." The Specification states: An in-vivo hydrolysable ester of a compound of formula (1) containing carboxy or 5 hydroxy group is, for

example. A pharmaceutically acceptable ester which is cleaved in the human or animal body to produce the parent acid or alcohol.

The Examiner states that the omitted structural cooperative relationship is the "in-vivo hydrolysable ester" of formula (1) and although the specification lists various example of esters, it is unclear how many esters are present and where the esters are located on the structure.

Again, whilst Applicants do not agree with the Examiner on this point, the term has been removed from the claims in order to Expedite prosecution.

Applicants re-iterate their request rejoinder of the process claims, claims 16 and 20-22, finding basis in the MPEP at section 821.04(b) under Rejoinder of Process Requiring an Allowable Product where it is stated that:

... if applicant elects a claim(s) directed to a product which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must depend from or otherwise require all the limitations of an allowable product claim for that process invention to be rejoined. Upon rejoinder of claims directed to a previously nonelected process invention, the restriction requirement between the elected product and rejoined process(es) will be withdrawn.

Applicants believe that the present circumstances fulfill this set of criteria and respectfully request that the process claims, 16 and 20-22, are rejoined. Claims 16 and 20-22 are dependent on claim 1, and thus contain all the limitations of claim 1.

The above amendments have been made without prejudice to Applicants right to prosecute any cancelled subject matter in a timely filed continuation application.

Applicants believe the application is in condition for allowance, which action is respectfully requested.

A petition for a 1 month extension of time is being filed herewith, the Commissioner is hereby authorized to charge any deficiency in the fees or credit any overpayment to deposit account No. 50-3231, referencing Attorney Docket No. 101160-1P US.

Application No. 10/566,068
Amendment Dated 10/15/2007
Reply to Office Action of 06/14/2007

Respectfully submitted,

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